

REMARKS

Claims 1 through 6 and 9 through 14 are pending in this Application. Claim 1 has been amended to address a typographical oversight. Adequate descriptive support for new claims 9 through 14 should be apparent from Figs. 2 and 3. Applicants submit that the present Amendment does not generate any new matter issue.

The Examiner's Courtesy

Applicants express appreciation for Examiner Mooney's courtesy and professionalism in conducting a telephonic interview on February 18, 2004, after issuance of the Final Office Action dated January 2, 2004. During that interview, several issues were discussed under the first paragraph 35 U.S.C. §112.

As elaborated upon *infra*, the new matter issue raised by the Examiner under 35 U.S.C. §132 was discussed. It was noted that according to page 9, lines 5 through 9 and Table I, the loss of the dispersion compensated fiber that can compensate the chromatic dispersion of the transmission fiber at the 1550 nm wavelength is 2.8 dB at 1550 nm (Examples 3 and 4). As disclosed at page 9, lines 3 to 5, the length of the optical transmission fiber is 80 km. Accordingly, the loss of the module at the 1550 nm per unit kilometer of the optical transmission fiber can be easily calculated by dividing 2.8 dB by 80 km which equals the 0.035 dB/km limitation appearing in claim 1.

In addition, adequate descriptive support for new claims 9 and 10 was discussed. It was mentioned that Figs. 2 and 3 provide such adequate descriptive support.

During the interview, Examiner Mooney agreed that with the above positions. Specifically, Examiner Mooney agreed that adequate descriptive support for the limitation in

claim 1 for the loss of the module at the 1550 nm per unit kilometer of the optical transmission fiber is adequately disclosed to be 0.035 dB/km. In addition, Examiner Mooney agreed that Figs. 2 and 3 provide adequate descriptive support for the limitations in claims 9 and 10 with respect to the average chromatic dispersion.

Again, Examiner Mooney's courtesy and professionalism extended in conducting an interview subsequent to the Final Office Action is appreciated. Set forth below are the issues raised in the Office Action dated January 2, 2004.

The Assertion of New Matter

On page 2 of the January 2, 2004 Office Action, the Examiner asserted that the limitation "0.035 dB/km" is not disclosed where asserted. This objection is traversed.

Applicants regret not providing the Examiner with more explicit information when submitting the October 23, 2003 Amendment. As discussed above, adequate descriptive support for the loss per unit kilometer of 0.035 dB/km can be easily calculated from page 9 of the written description of the specification, lines 3 through 9, Examples 3 and 4 and Table I. Specifically, the loss of the dispersion compensating fiber that can compensate the chromatic dispersion of the transmission fiber at the 1550 nm wavelength is disclosed as 2.8 dB at 1550 nm of Examples 3 and 4 in Table I at page 9 of the written description of the specification. At page 9 of the written description, lines 3 through 9, it is disclosed that the optical transmission fiber of Examples 3 and 4 has a length of 80 km. Accordingly, the loss of the module at the 1550 nm per unit kilometer of the optical transmission fiber can be easily calculated by dividing 2.8 dB by 80 km which equals the "0.035 dB/km" limitation of claim 1.

As previously pointed out, the Examiner agreed that the “0.035 dB/km per unit kilometer” limitation of claim 1 finds adequate descriptive support in the originally filed disclosure within the meaning of the first paragraph 35 U.S.C. §112. Accordingly, the objection imposed under 35 U.S.C. §132 is not factually appropriate and, hence, Applicants solicit withdrawal thereof.

Claim 1 was rejected under the first paragraph of 35 U.S.C. §112 for lack of adequate descriptive support.

In the statement of the rejection, the Examiner asserted that there is no adequate descriptive support in the originally filed disclosure for the specific range of average chromatic dispersion of -0.12 and including 0.1. This rejection is traversed.

The reason Applicants traverse this rejection is that the limitation identified by the Examiner is no longer found in any of the claims. New claims 9 and 10 recite, respectively, an average chromatic dispersion range of not less than -2 and not more than 2, and not less than -1 and not more than 1, the units being ps/nm/km. As mentioned above, the Examiner agrees that adequate descriptive support for these limitations appears in Figs. 2 and 3.

Applicants therefore submit that one having ordinary skill in the art would have understood from the originally filed disclosure that Applicants invented the now claimed subject matter. *Union Oil Co. of California v. Atlantic Richfield Co.* 208 F.3d 989, 54 USPQ2d (Fed. Cir. 2000) 1227. Applicants, therefore, submit that the imposed rejection of claim 1 under the first paragraph of 35 U.S.C. §112 is not viable and, hence, solicit withdrawal thereof.

Claim 6 was rejected under 35 U.S.C. §103 for obviousness predicated upon Judy et al. in view of Sillard et al.

This rejection is traversed.

Applicants submit that neither of the applied references discloses or suggests an optical transmission system as claimed, having a receiver wherein the loss of the module at the 1550 nm per unit kilometer of the optical transmission fiber is 0.035 dB/km, as set forth in claim 6. In this respect, Applicants would note that regardless of whether a limitation is considered to find adequate descriptive support in the specification, it must be given consideration as a claim limitation for purposes of 35 U.S.C. §103. *Ex parte Grasselli*, 231 USPQ 393 (Bd.App. 1983), *aff'd. mem.*, 738 F.2d 453 (Fed. Cir. 1984).

As neither of the applied references discloses an optical transmission system wherein loss of the module at the 1550 nm wavelength is not more than 0.035 dB/km of the optical transmission fiber, even if the applied references are combined the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Applicants, therefore, submit that the imposed rejection of claim 6 under 35 U.S.C. §103 for obviousness predicated upon Judy et al. in view of Sillard et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

New Claims 9 through 14.


New claims 9 through 14 are free of the applied prior art. Applicants submit that the applied prior art neither discloses nor suggests an optical transmission line having the recited characteristics, including the average chromatic dispersion recited in claims 9 and 10.

Based upon the foregoing it should be apparent that the objection and rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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